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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,800	11/06/2000	Yushi Matsukubo	862.C2042	6045
5514	7590	08/25/2004	EXAMINER JONES, DAVID	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			ART UNIT 2622	PAPER NUMBER
DATE MAILED: 08/25/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

09/705,800

Applicant(s)

MATSUKUBO ET AL.

Examiner

David L Jones

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: fig. 1, #212, fig. 7, #S77-2, figs. 9A, 9B, 9C, and 9D, #905-911. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
3. Figure 6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The

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replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 7, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kageyama et al. (US 5,954,436).

Regarding claim 1, Kageyama et al. discloses an image forming system having an image information generation apparatus for generating image information, and an image forming apparatus capable of forming images on both sides of a printing medium on the basis of the image information generated by the image information generation apparatus,

the image information generation apparatus comprising:

image information generation means (fig. 1, #100, column 6, lines 51-66) for generating image information;

storage means for storing the generated image information to allow identifying whether the image information is image information to be printed on a first surface or a second surface of

the printing medium, Kageyama does not explicitly disclose that the host computer has any type of RAM, ROM, or hard drive it would have been inherent that it contain all of them, further as shown in figure 1, #101 which is the single/double-sided printing specifying command issuing unit;

reception means (108) for receiving a predetermined signal from the image forming apparatus (column 10, lines 56-67, and column 11, lines 1-38);

selection means (101) for selecting one of the image information to be printed on the first surface of the medium and image information to be printed on the second surface on the basis of the predetermined signal received by said reception means; and

transmission means (108) for reading out the image information selected by said selection means from said storage means and transmitting the information to the image forming apparatus, and

the image forming apparatus comprising:

transmission means (110, column 11, lines 1-10) for transmitting the predetermined signal; and

image forming means (1131) for forming an image on the first surface or the second surface of the medium on the basis of the image information transmitted from the image information generation apparatus.

Regarding claim 2, Kageyama discloses an image forming system wherein the image forming generation means (fig. 5, column 8, lines 41-60) generates the image information on the basis of PDL data sent from a host computer.

Regarding claim 3, Kageyama discloses (column 11, lines 5-10) an image forming system wherein the image forming apparatus comprises transmission request means for requesting transmission of the image information of the first or second surface.

Regarding claim 4, Kageyama discloses (column 7, lines 37-50) an image forming system wherein the image information generation apparatus comprises page information transmission means capable of transmitting page information related to image information of a plurality of pages to the image forming apparatus in advance.

Regarding claim 5, Kageyama discloses (column 7, lines 37-50) an image forming system wherein the page information includes pieces of information including the number of pages, a paper feed position, and a paper discharge position.

Regarding claim 7, Kageyama discloses (column 7, lines 37-50) an image forming system wherein said image forming means selects the paper feed position and discharge position in accordance with the page information.

Regarding claim 11, Kageyama discloses an image information generation apparatus for generating image information to be transmitted to an image forming apparatus capable of forming images on both sides of a printing medium, comprising:

image generation means (fig. 1, #100, column 6, lines 51-66) for generating image information;

storage means for storing the generated image information to allow identifying whether the image information is image information to be printed on a first surface or a second surface of the printing medium, Kageyama does not explicitly disclose that the host computer has any type of RAM, ROM, or hard drive it would have been inherent that it contain all of them, further as

shown in figure 1, #101 which is the single/double-sided printing specifying command issuing unit;

reception means (108) for receiving a predetermined signal from the image forming apparatus (column 10, lines 56-67, and column 11, lines 1-38);

selection means (101) for selecting one of the image information to be printed on the first surface of the medium and image information to be printed on the second surface on the basis of the predetermined signal received by said reception means; and

transmission means (108) for reading out the image information selected by said selection means from said storage means and transmitting the information to the image forming apparatus.

Regarding claim 12, arguments analogous to those presented for claim 2.

Regarding claim 13, arguments analogous to those presented for claim 4.

Regarding claim 14, arguments analogous to those presented for claim 5.

Regarding claim 15, Kageyama discloses (column 12, lines 43-62) an image forming system wherein said apparatus sends the image information as a pair to be printed on the first and second surface of the medium, after said image information are made ready. As detailed by Kageyama, that the buffer memory can hold up to 10 pages at a time, it would be inherent that if both sides are ready that both are sent, but the system can hold up to 10 pages, so that 10 pages can be sent at a time.

Regarding claim 16, Kageyama discloses an image forming apparatus capable of forming images on both sides of a printing medium on the basis of image information generated by an image information generation apparatus, comprising:

determination means (210), column 7, lines 51-67, and column 8, lines 1-18) for identifying whether the image is to be printed on a first surface or a second surface of the printing medium;

transmission means (110, column 11, lines 1-38) for transmitting a predetermined signal representing a determination result of said determination means; and

image forming means (1131) for forming an image on the first surface or the second surface of the printing medium on the basis of the image information transmitted from the image information generation apparatus.

Regarding claim 19, arguments analogous to those presented for claims 4 and 5.

Regarding claim 20, Kageyama discloses (column 11, lines 36-67) an image forming apparatus wherein said apparatus comprises determination means for determining whether the image is to be printed on the first surface or second surface of the printing medium, and said predetermined signal transmission means transmits the predetermined signal representing a determination result of said determination means.

Regarding claim 21, Kageyama et al. discloses an image forming method having an image information generation module for generating image information, and an image forming module capable of forming images on both sides of a printing medium on the basis of the image information generated by the image information generation module,

the image information generation module comprising:

image information generation step (fig. 1, #100, column 6, lines 51-66) for generating image information;

storage step for storing the generated image information to allow identifying whether the image information is image information to be printed on a first surface or a second surface of the printing medium, Kageyama does not explicitly disclose that the host computer has any type of RAM, ROM, or hard drive it would have been inherent that it contain all of them, further as shown in figure 1, #101 which is the single/double-sided printing specifying command issuing unit;

reception step (108) for receiving a predetermined signal from the image forming module (column 10, lines 56-67, and column 11, lines 1-38);

selection step (101) for selecting one of the image information to be printed on the first surface of the medium and image information to be printed on the second surface on the basis of the predetermined signal received by said reception step; and

transmission step for reading out the image information selected by said selection step from said storage step and transmitting the information to the image forming module, and

the image forming module comprising:

transmission step (110, column 11, lines 1-10) for transmitting the predetermined signal; and image forming step (1131) for forming an image on the first surface or the second surface of the medium on the basis of the image information transmitted from the image information generation module.

Regarding claim 22, arguments analogous to those presented for claim 2.

Regarding claim 23, arguments analogous to those presented for claim 3.

Regarding claim 24, arguments analogous to those presented for claim 4.

Regarding claim 25, arguments analogous to those presented for claim 5.

Regarding claim 27, arguments analogous to those presented for claim 7.

Regarding claim 31, Kageyama discloses an image information generation method for generating image information to be transmitted to an image forming module capable of forming images on both sides of a printing medium, comprising:

image generation step (fig. 1, #100, column 6, lines 51-66) for generating image information;

storage step for storing the generated image information to allow identifying whether the image information is image information to be printed on a first surface or a second surface of the printing medium, Kageyama does not explicitly disclose that the host computer has any type of RAM, ROM, or hard drive it would have been inherent that it contain all of them, further as shown in figure 1, #101 which is the single/double-sided printing specifying command issuing unit;

reception step (108) for receiving a predetermined signal from the image forming module (column 10, lines 56-67, and column 11, lines 1-38);

selection step (101) for selecting one of the image information to be printed on the first surface of the medium and image information to be printed on the second surface on the basis of the predetermined signal received by said reception step; and

transmission step (108) for reading out the image information selected by said selection step from said storage step and transmitting the information to the image forming module.

Regarding claim 32, arguments analogous to those presented for claim 2.

Regarding claim 33, arguments analogous to those presented for claim 4.

Regarding claim 34, arguments analogous to those presented for claim 5.

Regarding claim 36, Kageyama discloses an image forming method capable of forming images on both sides of a printing medium on the basis of image information generated by an image information generation module, comprising:

determination step (210), column 7, lines 51-67, and column 8, lines 1-18) for identifying whether the image is to be printed on a first surface or a second surface of the printing medium;

transmission step (110, column 11, lines 1-38) for transmitting a predetermined signal representing a determination result of said determination step; and

image forming step (1131) for forming an image on the first surface or the second surface of the printing medium on the basis of the image information transmitted from the image information generation module.

Regarding claim 39, arguments analogous to those presented for claims 4 and 5.

Regarding claim 40, arguments analogous to those presented for claim 20.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 8, 10, rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama et al. (US 5,954,436).

Regarding claim 8, Kageyama discloses an image forming system wherein the

image forming apparatus further comprises determination means for determining whether the image is to be printed on the first surface or the second surface of the printing medium, and said predetermined signal transmission means (column 11, lines 1-10) transmits the predetermined signal representing a determination result of said determination means, as shown by Kageyama that the printer is sending back to the host computer when a page or job is completed.

As detailed by Kageyama, the printer unit is sending data back to the host computer when a page is completed, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that printer is sending back to the host computer whether the surface is the first or second.

Regarding claim 10, Kageyama discloses (column 11, lines 5-10) an image forming system wherein said determination means identifies on the basis of a convey state of the printing medium whether the image is to be printed on the first surface or the second surface of the printing medium. As detailed by Kageyama, the printer unit is sending data back to the host computer when a page is completed, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that printer is sending back to the host computer whether the surface is the first or second.

Regarding claim 17, Kageyama discloses (column 11, lines 1-10) an image forming apparatus wherein the transmission request means for requesting transmission of the image information of the first surface or the second surface. As detailed by Kageyama, the printer unit is sending data back to the host computer when a page is completed, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that printer is

sending back to the host computer whether the surface is the first or second. Further, as shown in column 12, lines 43-62, that the printer as each page is completed requests the next from the host computer and therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made the printer is requesting either the first or second surface.

Regarding claim 28, arguments analogous to those presented for claim 8.

Regarding claim 30, arguments analogous to those presented for claim 10.

Regarding claim 37, arguments analogous to those presented for claim 17.

8. Claims 6, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama et al. as applied to claims 1-5, 7-8, 10-11 above, and further in view of Iwase et al. (US 6,724,492).

Regarding claim 6, Kageyama teaches (column 11, lines 1-10) an image forming apparatus that can print on both sides of a medium that is sent through the system. But Kageyama does not explicitly detail that the printer is a four-color printer.

Whereas, Iwase et al. (Iwase) teaches (column 12, lines 36-40) in figure 14, item #245, the ability to print in a photograph mode. Further, in figure 19, shows (column 13, lines 61-67, and column 14, lines 1-20) each of the independent color settings.

Kageyama and Iwase are analogous art because they both are from the same field of endeavor, printing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the color printing of Iwase with the system of Kageyama.

The suggestion/motivation for doing so would have been to provide the user the ability to print in monochrome mode and to print in color mode.

Therefore, it would have been obvious to combine Kageyama with Iwase to obtain the invention as specified in claim 6.

Regarding claim 9, Kageyama teaches (column 11, lines 1-10) an image forming apparatus that can print on both sides of a medium that is sent through the system. But Kageyama does not explicitly detail that the ability of the printer to read an original on a scanning surface.

Whereas, Iwase (fig. 2, #11, column 4, lines 3-16) teaches the printer has a scanner section 11 has a CCD sensor, which converts the light reflected from an original document in an electric image signal.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the color printing of Iwase with the system of Kageyama.

The suggestion/motivation for doing so would have been to provide the user the ability to convert an original to an electrical image signal for printing.

Therefore, it would have been obvious to combine Kageyama with Iwase to obtain the invention as specified in claim 9.

Regarding claim 18, arguments analogous to those presented for claim 6.

Regarding claim 26, arguments analogous to those presented for claim 6.

Regarding claim 29, arguments analogous to those presented for claim 9.

Regarding claim 35, arguments analogous to those presented for claim 9.

Regarding claim 38, arguments analogous to those presented for claim 6.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (7:00am - 3:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David L. Jones



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